



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/678,356

10/02/2003

Robert E. Kahn

06154-011004

1815

26161 7590 12/26/2006
FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

PAN, JOSEPH T

ART UNIT

PAPER NUMBER

2135

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
----------------------------------------	-----------	---------------

3 MONTHS

12/26/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/678,356

Applicant(s)

KAHN ET AL.

Examiner

Joseph Pan

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/28/04&10/2/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

ABSTRACT

1. The abstract of the disclosure is objected to because there are extraneous characters "181925.B11 ". Correction is required. See MPEP 608.01(b).

Claim Rejections - 35 USC § 102 (e)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 (e) that form the basis for the rejections under this section. made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-50, are rejected under 35 U.S.C. 102 (e) as being anticipated by Wyman (U.S. Patent No. 5,260,999).

Referring to claims 1, 7, 11, 21, 22, 26, 32, 33, 43:

Wyman discloses the claimed method of managing digital objects in a network, the method comprising:

Storing the digital objects (license server, database 23, Figure 1) at locations accessible in the network using a storage technique which renders the digital objects secure (the term secure is interpreted as a product use authorization) against unauthorized access (e.g. see, Abstract, lines 3-8, col 23, lines 30-42),

Storing pointer information (filter function, or the license manager 14 can simulate the effect of potential assignment, see, col 45, lines 6-8, in which filter or license manager selecting information from store of license authorizations, database 23) which associates each digital object identifier with a pointer indicating the location of the stored digital object in the network (e.g. see, Abstract, lines 32-34, col 11, lines 54-67, col 46, lines 20-47), and

For each of the digital objects, storing, separately from the digital object, validation information sufficient to permit a determination whether a purported instance of a digital object is identical to the original (e.g. see, Abstract, lines 4-14, col 1, lines 33-47, col 10, lines 30-45).

Wyman also discloses the step of storing the verification information separately from the digital object (e.g. see, col 13, lines 18-27, col 15, lines 22-31).

Referring to claim 2:

Wyman discloses the claimed method of permitting an authorized user to have access to the validation information, using the digital object identifier, to determine whether a purported instance of a digital object is identical to the original instance (e.g. see, Abstract, lines 4-14, col 1, lines 33-47, col 6, lines 40-61, col 14, lines 26-61).

Referring to claim 3:

Wyman discloses the claimed method wherein the validation information comprises a digital signature over the digital object (e.g. see, col 14, lines 26-61).

Referring to claim 4:

Wyman discloses the claimed method of managing reference information about digital objects in a network, each of the digital objects comprising a set of sequences of digits and having an associated identifier which is unique across the network, the method comprising:

Storing the digital objects (e.g. see, col 11, lines 10-30, col 23, lines 30-46),

Storing reference information for each of the digital objects (e.g. see, col 7, lines 22-39, col 9, lines 54-64, col 46, lines 29-47), and

Storing validation information for each of the digital objects which is substantially smaller in size than the corresponding digital object and which enables a determination of whether a purported instance of a digital object is identical to the original instance (e.g. see, col 14, lines 26-67, col 15, lines 1-64).

Referring to claim 5:

Wyman discloses the claimed method of permitting authorized users to have access to the reference information using the unique identifier (e.g. see, Abstract, lines 3-14, col 46, lines 20-47).

Referring to claims 6, 29-31:

Wyman discloses the claimed method wherein the reference information comprises information concerning at least one of the following:

registration of rights in digital objects (e.g. see, Abstract, lines 4-8); accesses to and uses of digital objects (e.g. see, col 1, lines 33-47); terms (validation) and conditions (authorizations) for access and use of digital objects (e.g. see, col 1, lines 50-59, col 11, lines 3-51); the ownership and licensing of rights to digital objects; links between different digital objects (e.g. see, col 7, lines 49-68, col 8, lines 1-3).

Referring to claims 8, 9, 34:

Wyman discloses the claimed method wherein the pointer versus identifier information is stored in multiple servers on the network, and the identifiers are generated in a manner to distribute the pointer versus unique identifier information relatively evenly among the servers (e.g. see, col 13, lines 18-39, col 15, lines 18-41, col 42, lines 11-20, col 46, lines 29-33).

Referring to claims 10, 23, 24, 27, 28, 37, 46, 47:

Wyman discloses the claimed method of providing multiple pointer servers (license managers 14, Figure 1) each of which accepts identifiers of a subset of the digital objects and returns corresponding pointers to the locations of the digital objects in the network (e.g. see, Figure 1, Element 13, col 9, lines 35-68, col 12, lines 60-68),

Providing a directory server (license server) which accepts identifiers of the digital objects and returns the locations of the pointer servers which accept those identifiers (e.g. see, col Abstract, lines 3-14, col 11, lines 3-30).

Referring to claims 12, 15, 45:

Wyman discloses the claimed method of storing the digital objects in the network in a manner that permits only authorized access (e.g. see, Abstract, lines 3-14, col 1, lines 48-59),

Storing, in the network, information about terms (validation) and conditions (authorizations) for access to each digital object (e.g. see, col 1, lines 48-59, col 11, lines 3-68, col 12, lines 1-17),

Making the information about terms and conditions available to a user in connection with a request for access to a digital object (e.g. see, col 21, lines 22-45),

Permitting access to the user only upon the user indicating assent to the terms and conditions (e.g. see, col 11, lines 3-51).

Referring to claim 13:

Wyman discloses the claimed method of storing, in the network, terms and condition for licensing rights (e.g. see, col 1, lines 27-60),

Providing information on terms and conditions pertaining to works or other information or material that the digital object may be based on or incorporate (e.g. see, col 1, lines 48-59),

Making the terms and conditions available to potential rights holders and users, as appropriate, upon request via the network (e.g. see, col 21, lines 22-45),

Enabling the potential rights holder aid the current rights holder to interact via the network to reach agreement on terms and conditions for grant of rights (e.g. see, col 11, lines 3-51),

Storing, in a recordation server on the network, information identifying grants of rights for digital objects on the network (e.g. see, Abstract, lines 3-14, col 1, lines 48-59).

Referring to claims 14, 35, 36, 41:

Wyman discloses the claimed method of storing in the network information which associates with each of the unique identifiers, a pointer to a rights management system including a terms and conditions server containing terms and conditions (e.g. see, col 36, lines 45-64, col 37, lines 1-23),

Providing to the user in response to presentation of a unique identifier the pointer to the terms and conditions server (e.g. see, col 26, lines 10-64, col 2 7, lines 1-23, col 46, lines 39-46);

Providing to the user in response to presentation of the pointer, terms and conditions information (e.g. see, col 21, lines 22-45);

Enabling the user to indicate assent to the terms and conditions (e.g. see, col 11, lines 3-51);

In response to the assent, permitting the user to access the digital object including performance of the object (e.g. see, Abstract).

Referring to claims 16, 38, 48- 50:

Wyman discloses the claimed method of storing, repository (storage medium) which is accessible on a wide are network, copies of the digital objects, in a manner that enables only authorized accesses to the digital objects and permits verification that the stored digital objects have not been subjected to unauthorized alteration, at an information and reference server which is accessible on the network at a difference network address from the repository, providing registration services including receipt via the network of registration requests and delivery via the network of

registration certifications, and accessing, from the repository via the network, the objects for use in providing the registration services (e.g. see, col 7, lines 22-39, col 9, lines 54-64, col 32, lines 53-61, col 40, lines 1-39).

Referring to claims 17, 39, 40, 42, 44:

Wyman discloses the claimed method of enabling owners rights in digital objects to deposit copies of the digital objects in the repository, via the network (e.g. see, Abstract).

Referring to claims 18, 19, 20, 25:

Wyman discloses the claimed method of providing a service, accessible on the network, for generating a unique handle for each digital object (e.g. see, Abstract, col 1, lines 30-46, col 32, lines 53-61, col 36, lines 35-40).

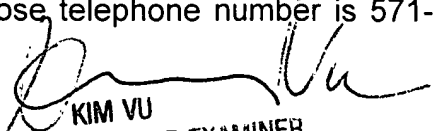
Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Pan whose telephone number is 571-272-5987.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100